



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/369,570	08/06/1999	MARCELLO TONCELLI	DRAGO-P86-RE	6991

7590 09/08/2003

LACKENBACH SIEGAL
ONE CHASE ROAD
SCARSDALE, NY 10583

EXAMINER

AFTERGUT, JEFF H

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 09/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/369,570

Applicant(s)

TONCELLI, MARCELLO

Examiner

Jeff H. Aftergut

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-45, 52-54 and 58-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-45, 52-54, 58-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Reissue Applications

1. Claims 65-73 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In U.S. Patent 5,670,007 (of which this application is a reissue), the sole independent claim recited the following limitations:

“providing a slab of stone material having a rear substantially smooth face **free of grooves or recess**.”(emphasis added)

This is an “omitted limitation” in the independent claims in this application (09/369,570). More specifically, claim 65 as amended recites “forming grooves or recesses on the rear face of the slab”. “A reissue claim is broadened where some limitation of the patent is no longer in the reissue claim,” see MPEP 1412.02, page 1400-9, Rev. 2, Feb. 2000. The independent reissue claims have been broadened to omit the limitation relating to the inclusion of grooves or recesses in the rear face of the stone slab material (claim 65).

Art Unit: 1733

If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists. " MPEP 1412.02, page 1400-9, Rev. 2, Feb 2000. the limitation regarding the substantially smooth face and the lack of grooves and recesses in the rear face were *presented* by appellant in the response dated 12-23-96 (a copy of which was made of record with the Examiner's Answer dated 2-23-01). The response was filed by applicant in an attempt to overcome a prior art rejection postulated by the examiner. these limitation were strenuously *argued* by applicant in the response dated 12-23-96 in the patented file where applicant argued that:

"Also emphasis has also been added to the claim to establish that it is a rear face of the stone slab material which is free from grooves or recesses, because as will be pointed out, this is another distinction from the prior art.", see page 5 of the response.

Additionally appellant is referred to page 7 of the response dated 12-23-96 where appellant argues that:

"Clearly, Toncelli '015 calls for the formation of grooves, and the placement of the rods in the grooves, and then the placement of resin into the grooves. Applicant starts out with a non-grooved surfaces, and creates the formation of areas between which the resin is inserted by calling for the provision of the non-twisted linear reinforcing elements on to a rear face of a slab of stone material having a rear face free of grooves or recesses. This clearly removes all of the references of record, because the main references has been removed, and therefore the modifying references have also been removed."

The applicant is additionally advised that in response to the amendment filed by applicant dated 12-23-96 the examiner allowed claims 1-6 and 8-21 and presented the following reasons for allowance in the patented file (to which there were no comments made by applicant in response to the same):

Art Unit: 1733

"None of the prior art of record teaches disposing a reinforcing layer between the linear reinforcing elements and the rear face of the slab of stone material (where rear face of the stone material was substantially smooth and free from grooves or recesses)".

Clearly, the reason that the earlier claims were allowed was because the rear face of the stone slab was substantially smooth and free from grooves or recesses and there was a layer of reinforcing material between the linear non-twisted members and the rear face of the slab.

Hence, the above noted "omitted limitations" was originally *presented* and strenuously *argued* in the original application to render the claims allowable over a prior art rejection and the examiner's reasons for allowance indicated that the "omitted limitations" distinguished over the prior art. The above noted omitted limitations therefore relate to subject matter previously surrendered in the original application.

"Reissue claims that are broader in certain aspects and narrower in other vis-à-vis claims canceled from the original application to obtain a patent may avoid the effect of the recapture rule if the claims are broader in a way that does not attempt to reclaim what was surrendered earlier." MPEP 1412.02 (REISSUE CLAIMS ARE BROADER IN SCOPE IN SOME ASPECTS, BUT NARROWER IN OTHERS). Also: "[i]f the reissue claim is as broad as or broader in an aspect germane to prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim", *In re Clement*, supra at 1165. The independent reissue claim 1 is "narrower" in scope than the patented claim since the claim requires that there be a **layer** of non-twisted linear reinforcing elements **applied to the rear face of the slab** (emphasis added). These narrowing limitations, however are **not** at all related to the "omitted limitations" of an insertion of a layer of reinforcement between the coated non-twisted reinforcing elements and the rear face of the slab of stone material and the manner in which they

Art Unit: 1733

defined over the prior art. Since the narrowing aspect is not related to the prior art rejection and not related to the subject matter surrendered in the original application, recapture exists and claims 65-73 are properly rejected under 35 USC 251. The independent reissue claim 65 is "narrower" in scope than the patented claim since the claim requires grooves into which linear reinforcing elements are inserted with the prescribed amount of resin therein, it requires that a layer of non-twisted linear reinforcing elements were applied to the rear face of the stone slab, and the hardening of the resin wherein two layers of liner reinforcing elements are associated with the rear of the stone slab. These added, narrowing limitations are not at all related to the "omitted limitation" of an insertion of a layer of reinforcement between the coated non-twisted reinforcing elements and the rear face of the slab and additionally are not related to the lack of grooves on the rear face of the slab which was substantially smooth. Since the narrowing aspect is not related to the prior art rejection and not related to the subject matter surrendered in the original application, recapture exists and claims 65-73 are properly rejected under 35 USC 251.

2. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

3. This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest in order to support the consent to a reissue application required by 37 CFR 1.172(a). The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action.

4. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 39-45 and 52-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent 6-64076 in view of Webster's II New Riverside University Dictionary and any one of Japanese Patent 4-231545, PCT WO 91/09733 or French Patent 2429100.

Japanese Patent '076 taught the basic operation as claimed including the reinforcement of the backside of a smooth natural stone with resin impregnated fibers wherein the backside of the stone was free from grooves or recesses. The reference suggested that those skilled in the art would have applied a glass fiber or carbon fiber fabric layer 104 to the backside of the stone wherein disposed between the glass fiber fabric and the stone was a reinforcing layer formed of

Art Unit: 1733

resin 6 and fibers 2 which made up reinforcing layer 102. The reference expressly stated that more reinforcement than resin would have been useful in the reinforcing layers. The applicant takes the position that the layer 102 formed from fibers 2 was formed of fibers that were twisted. Applicant's own translation of the reference to Japanese Patent '076 suggested that the filaments were converged with a converging agent or they were twisted (so that twisting is an alternative to a converging agent for retaining the fibers). That being said, the fibers 2 of layer 102 in Japanese Patent '076 are the reinforcing layer disposed between the layer of reinforcement which contains the non-twisted linear reinforcing elements and the slab of stone. More specifically layer 104 has been interpreted to be the layer of reinforcement which contains the linear non-twisted reinforcing elements. Applicant has defined this layer to be in the form of glass fibers contained in a matting (see claims 40 and 41). The reference to Japanese Patent '076 refers to layer 104 as being a fabric or cloth of glass fibers but never expressly states that the layer of fabric or glass cloth was a "matting".

"Matting" is defined in Webster's II New Riverside University Dictionary as "Coarsely woven fabric for covering floors". The reference to Japanese Patent '076 suggested that the fabric used was one which was woven of glass fibers but it did not expressly suggest that it was one which was "coarsely woven". However, in the art of reinforcing a stone slab with a fabric layer, it was known as evidenced by either one of Japanese Patent '545 or PCT '733 to provide a "matting" of woven glass fibers as the reinforcement material. More specifically, Japanese Patent '545 suggested that "coarse woven fabric of glass fibre" was used with a resin as reinforcement for a stone slab (see reinforcement of coarsely woven fabric 3 in resin layer 4 of the reference and the abstract of the disclosure of the reference provided both from the Japanese Patent Office

Art Unit: 1733

and Derwent). The reference to French Patent '100 suggested that "glass fibre cloth or matting" was used as a reinforcing layer for the backside of a stone slab (suggesting that in the art of making a reinforced stone slab the use of cloth or matting were art recognized equivalents). Lastly, note that the reference to PCT '733 clearly expressed that the layer of reinforcement 5 disposed on the backside of the stone slab was a matting of glass fiber, see the abstract of the disclosure, page 5, lines 11-19, for example. Clearly, it would have been understood from a viewing of Japanese Patent '076 that one skilled in the art at providing the reinforced backing material therein for the stone slab would have recognized that a suitable woven material made of glass fibers would have included a matting of coarsely woven glass fibers as such material were conventionally utilized in the art for reinforcing stone slabs as evidenced by any one of Japanese Patent 4-231545, PCT WO 91/09733 or French Patent 2429100. The position of the Office is that a matting of coarsely woven glass fibers is the material that applicant is utilizing for the reinforcement of the stone slab which included the linear non-twisted fiber reinforcement. Because matting materials were known for the same purpose, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a matting for the reinforcing layer 104 of Japanese Patent '076 as a matting layer was defined as a coarsely woven fabric (as evidenced by Webster's II New Riverside University Dictionary) and such mattings were known woven fabric useful for supporting a stone slab in combination with resin impregnating the same as suggested by any one of Japanese Patent 4-231545, PCT WO 91/09733 or French Patent 2429100.

With regard to claim 40, the reference to Japanese Patent '076 suggested that the layer 104 included fibers of the fabric 4 which were either glass or carbon. With respect to claim 41,

Art Unit: 1733

the reference to any one of Japanese Patent 4-231545, PCT WO 91/09733 or French Patent 2429100 suggested that the matting would have been useful in the operation. Regarding claim 42, the reference to Japanese Patent '076 suggested the specified ratio of resin to reinforcement. Regarding claims 43 and 44, the reference to Japanese Patent '076 suggested stone slabs having the specified thicknesses. Regarding claim 45, note that Japanese Patent '076 suggested the use of stainless steel for the reinforcing fibers 2, see the translation, paragraph [0012] of the same. Regarding claim 52, note that the reference suggested the specified amount of resin to reinforcement. Regarding claim 53, note that Japanese Patent '076 suggested the use of slabs having the specified thicknesses. Regarding claim 54, the reference to Japanese Patent '076 clearly suggested the use of heating to harden the resin matrix, see paragraph [0025] of the reference.

7. Claims 58-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 6 further taken with Japanese Patent 63-242984.

The references as set forth above in paragraph 3 suggested the application of a single layer of matting against the backside of a slab for the reinforcement of the same (wherein the matting was taken to be made of fibers of glass which were non-twisted linear reinforcing members). The references, however, did not suggest that one skilled in the art at the time the invention was made would have incorporated a plurality of woven fabric layers for the backing of the stone slab to reinforce the same. However, the use of multiple fabric layers for reinforcing a stone slab such that the stone slab was allowed to be formed to be thin was known as evidenced by Japanese Patent '984. More specifically, Japanese Patent '984 suggested the use of a single layer of fabric for backing the stone slab as envisioned in Figure 1 where the slab 1 was

Art Unit: 1733

reinforced with a fabric 2 and a resin impregnated into the same 3 or the use of plural layers of woven fabric 5 which were likewise impregnated with a resin and disposed on the backside of a smooth flat stone slab 1, see Figure 2. Clearly, depending upon the strength of the reinforcing matting as well as the demands of the needed strength of the reinforcement applied, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide plural matting layers against the backside of the stone panel as suggested by Japanese Patent '984 wherein the materials of the matting would have included the specified glass fiber matting as described above in paragraph 6.

Note that the specifics of the amount of resin used, the types of fibers used for the matting, as well as the types of resins employed, the reference to Japanese Patent '076 discussed above suggested the same.

8. Claims 65-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over E.P. 631,015 in view of E.P. 623,714 further taken with Japanese Patent 6-64076 in view of Webster's II New Riverside University Dictionary and any one of Japanese Patent 4-231545, PCT WO 91/09733 or French Patent 2429100.

E.P. '015 and E.P. '714 are discussed at length in paper no. 19, paragraph 7. The references suggested that one skilled in the art would have provided reinforcing members of steel in grooves of the backside of a stone slab and additionally provided an additional layer of reinforcing material against such an arrangement. The references failed to make mention of the use of matting as the reinforcing layer of material applied to the backside of the stone (for the layer of reinforcement 52 in E.P. '714). However, as addressed above in paragraph 6, Japanese Patent '076 suggested that woven fabrics would have been impregnated with resin in the

Art Unit: 1733

specified amounts and used as reinforcement for the finished assembly. Certainly, the use of matting for the fabrics was well established as evidenced by Webster's II New Riverside University Dictionary and any one of Japanese Patent 4-231545, PCT WO 91/09733 or French Patent 2429100 as discussed above. The Japanese Patent '076 additionally expressly suggested that one would have provided unidirectionally disposed reinforcement against the slab between the slab and the matting layer, i.e. layer 102. The reinforcing layer 102 was formed of fibers which were steel or glass fibers. Note that the use of glass fiber instead of steel for the reinforcement in E.P. '015 disposed within the grooves would have therefore been an art recognized equivalent. While the reference did not expressly state what the dilation coefficient of the material was, one skilled in the art would have understood that the use of glass fiber with an epoxy resin would have had the same physical properties as that of the claimed invention.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 39-45 and 52-54 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, and 11 of U.S. Patent No. 6,205,727 in view of Japanese Patent 6-64076, Webster's II New Riverside University

Art Unit: 1733

Dictionary and any one of Japanese Patent 4-231545, PCT WO 91/09733 or French Patent 2429100.

The reference to U.S. Patent '727 has been discussed at length in paper no. 19 and applicant is referred to the same for a complete discussion of the reference. The reference failed to teach that one skilled in the art would have utilized multiple reinforcements for the backside of the stone slab, however the use of multiple reinforcements for the stone slab were known in the art as evidenced by Japanese Patent '076 and applicant is referred to paragraph 6 above for a complete discussion of the same. Additionally, the references to Webster's II New Riverside University Dictionary and any one of Japanese Patent 4-231545 or PCT WO 91/09733 or French Patent 2429100 further evidenced that those skilled in the art at the time the invention was made would have employed matting for the reinforcement which included non-twisted linear reinforcement therein. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the techniques of Japanese Patent '076 in the operation of U.S. Patent '727 in order to provide added reinforcement to the backside of the stone slab wherein the same included non-twisted linear reinforcement as suggested by Webster's II New Riverside University Dictionary and any one of Japanese Patent 4-231545, PCT WO 91/09733 or French Patent 2429100. applicant is referred to paragraph 6 above for a complete discussion of the secondary references as well as the dependent claims.

11. Claims 58-64 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, and 11 of U.S. Patent No. 6,205,727 in view of Japanese Patent 6-64076, Webster's II New Riverside University Dictionary and any one

Art Unit: 1733

of Japanese Patent 4-231545, PCT WO 91/09733 or French Patent 2429100 and Japanese Patent 63-242984 .

The applicant is referred to paragraph 7 above for a complete discussion of the references listed above as well as a statement of obviousness as to why one skilled in the art would have selected a single matting for the backing of the stone slab. The combination failed to make mention of the use of two coarse woven fabrics for the reinforcement of the stone slab, however the use of multiple reinforcements was known as evidenced by Japanese Patent '984. applicant is referred to paragraph 4 above for a complete discussion of Japanese Patent '984. it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ multiple layers of matting in order to attain the desired strength and stiffness to the finished panel assembly in the process of making a stone panel as suggested was known by Japanese Patent '984 in the operation of making a reinforced stone pane as taught by U.S. Patent '727 as modified by of Japanese Patent 6-64076, Webster's II New Riverside University Dictionary and any one of Japanese Patent 4-231545, PCT WO 91/09733 or French Patent 2429100.

Response to Arguments

12. Applicant's arguments filed 5-30-03 have been fully considered but they are not persuasive.

The applicant has overcome the 112 problems with the submission of the amendment and the rejections previously presented regarding the same are moot.

The applicant has not overcome the recapture problem as identified above. As expressed previously, the claims at hand have been broadened to include the formation of grooves or recesses on the backside of the slab. The allowed claims of the patent required that the backside

Art Unit: 1733

of the slab was substantially smooth and free of grooves or recesses. this was argued by applicant as overcoming the prior art applied to reject the claims and was identified in the reasons for allowance was one of the defining features of the claimed invention. Clearly, then, the incorporation of grooves or recesses in the slab is a broadening of the claim where applicant is attempting to recapture subject matter previously surrendered. Such is inappropriate in a reissue application.

Regarding the prior art rejection, the applicant is advised that those versed in the art would have understood to utilize a matting to reinforce the stone slab. As identified in claim 41, for example, the non-linear glass strands were in the form of a matting. The applicant is advised that while the references to Japanese Patent 4-231545, PCT WO 91/09733 or French Patent 2429100 do not expressly state that the glass fibers used therein were in the form of non-linear glass fibers, the reference clearly suggested that those versed in the art would have utilized glass fibers in the form of a matting as the reinforcements. The references are silent as to the use of twisted glass filaments (i.e. glass yarns) as used in the matting and appear to suggest that those skilled in the art of manufacturing a reinforced stone slab would have understood that matting would have been useful in such processing. The ordinary artisan would have been expected to employ ordinary glass fibers in the matting (lacking a suggestion that the same were twisted in the operation of weaving to form the matting), and thus it would have been understood by the references to any one of Japanese Patent 4-231545, PCT WO 91/09733 or French Patent 2429100 that the matting employed as a reinforcement did not have glass fibers in a twisted form but rather employed normal glass fibers disposed in a conventional matting configuration.

Art Unit: 1733

The applicant argues that the reference to Japanese Patent '076 placed no criticality on having a resin to fiber ratio of at most 50:50. the applicant is advised that while the reference did not guide one to utilize a ratio of less than 50:50, the reference expressly suggested that the useful range of the ratio was 80-30:20-70. thus the reference clearly expressed that 50-30:50-70 would have been useful in the operation. The fact that there is no express example of the resin content below 50% does not take away from the fact that the reference clearly included the use of resin contents well within the claimed range. The applicant is advised that while the reference did not express the specified advantage of closer matching of the coefficient of thermal expansion, it need not express the same advantage because it encompassed the range. The applicant is advised that while one can obtain a patent for a species of a genus, there must be evidence of unexpected results. Here, there is no evidence provided and additionally one would have expected (as it was commonplace in the art of bonding) to have attempted to match the coefficient of thermal expansion of the reinforcement to the slab as such was a prerequisite to ensuring that a bond was maintained in various environmental conditions (such as heat and cold).

Regarding the double patenting rejection, while the time for this patent may expire prior to the possible extension of the patent applied in the double patenting rejection, this is merely one premise for making the double patenting rejection (and the requirement for a terminal disclaimer). Another requirement is to maintain common ownership of the inventions for the life of the patents (so that there are not multiple suits involved in infringement for example). Applicant is still required to submit a terminal disclaimer which expressed that the applicant will maintain common ownership for the life of the patent.

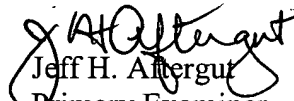
Art Unit: 1733

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff H. Aftergut whose telephone number is 703-308-2069. The examiner can normally be reached on Monday-Friday 6:30-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Jeff H. Aftergut
Primary Examiner
Art Unit 1733

JHA
September 4, 2003